

Appln No. 10/779,370
Amdt date August 7, 2006
Reply to Office action of June 8, 2006

REMARKS/ARGUMENTS

Claims 1-30 are pending in the above-referenced application.

Claims 1, 7, 8, 13, 18, 19, and 27 have been amended to further define Applicant's invention.

This is a response to the Office Action dated June 8, 2006 wherein the Examiner rejected claims 1-30 under §102(e) as being anticipated by Woehr et al. (US 6,117,108). In view of the remarks that follow, reconsideration and a notice of allowance are respectfully requested.

Interview Summary

An in-person interview was conducted Friday, August 4, 2006 with Kevin Woehr, Tom Dao, and Examiner Stigell in attendance. During the interview, the '108 reference and independent claims 1, 13, and 27 were discussed. A force-diagram of the clip of FIG. 1B of the '108 reference, which was relied on by the Examiner to reject the claims, was supplied during the interview to explain the mechanism employed by the prior art clip to grip the needle in the protective position. A copy of the force-diagram is also enclosed herein for completeness. It was agreed that the pending claims distinguish over FIGs. 1A and 1B of the '108 reference. The Examiner suggested that independent claims 1, 13, and 27 be amended to further make clear that the needle and the opening of the proximal wall cooperate to prevent relative movement between the two, which Applicant has done via the amendment to claims 1, 13, and 27 indicated above.

During the interview, the Examiner brought up the issue of obviousness-type double patenting in view of issued parent patent, No. 6,709,419. Although the obviousness-type double patenting rejection was not raised in the June 8, 2006 Office Action, Applicant agrees to file a terminal disclaimer to obviate the rejection, which is enclosed.

§102(e) Rejection of Claims 1-30 by Woehr et al. (US 6,117,108)

In rejecting claims 1-30, the Examiner contends that the '108 reference discloses all of the elements of the claimed catheter assembly. The Examiner relied on FIGs. 1A and 1B of the '108

Appln No. 10/779,370
Amdt date August 7, 2006
Reply to Office action of June 8, 2006

reference to disclose, inter alia, a catheter assembly comprising "proximal wall of the protective clip positioned at an angle to the axis of the needle such that the contacts the upper rim portion and the lower rim portion to frictionally cooperate with the circumferential rim" in the used position.

Preliminarily, for a reference to anticipate a claimed invention under §102(e), it must adequately meet the terms of the claimed invention interpreted in light of the specification of the application. As set forth in the statute, the single prior art reference must disclose each and every element of the claim under consideration. Moreover, it cannot be rebuilt or reoriented by the utilization of Applicant's teachings in an attempt to create an anticipatory structure.

Amended independent claim 1 recites, in part, a catheter assembly comprising a retracted position in which the catheter hub is disengaged from the nose section of the needle hub, the portion associated with the resilient arm of the protective clip no longer contacting the engagement surface on the interior cavity of the catheter hub, and the proximal wall of the protective clip positioned at an angle to the axis of the needle such that the needle contacts the first perimeter portion and the second perimeter portion of the perimeter to fix relative movement between the needle and the tip protector.

Amended independent claim 13 recites, in part, a catheter assembly wherein the needle protective clip is separable from the catheter hub when the needle tip enters the interior cavity of the catheter hub and the resilient portion of the needle protective clip is unbiased by the needle; whereupon further withdrawing of the needle further separates the second portion of the interior cavity of the catheter hub from the portion of the needle protective clip and the needle contacts the first perimeter portion and the second perimeter portion of the perimeter to fix relative movement between the needle and the tip protector.

Amended independent claim 27 recites, in part, a catheter assembly wherein when the needle moves from the ready position towards the retracted position, the clip engagement wall surface of the catheter hub and the engagement segment on the needle protective clip interact to prohibit relative movement between the catheter hub and the needle protective clip until the needle moves proximally of the needle distally blocking member whereupon the resilient

Appln No. 10/779,370
Amdt date August 7, 2006
Reply to Office action of June 8, 2006

member is no longer biased by the side of the needle, the needle distally blocking member moves to block the needle tip, and, whereupon further needle movement, the needle protective clip separates from the catheter hub and the needle contacts the first perimeter portion and the second perimeter portion of the perimeter to fix relative movement between the needle and the tip protector.

As discussed during the in-person interview, each of the independent claims recite a tip protector that engages with a wall surface of the interior wall surface of the catheter hub and that has a proximal wall that cants over to contact the needle along two portions or a perimeter of the opening. As shown above, independent claims 1, 13, and 27 have also been amended to further clearly recite a limitation wherein the contact between the opening on the proximal wall and the needle is to fix relative movement between the needle and the tip protector.

In contrast, FIGs. 1A and 1B of the '108 Woehr et al. reference discloses a tip protector having an opening 58 on a proximal wall 54 to counter-act a rotational force generated by the arm of the first opening 56. As such, as shown in the force-diagram, the opening 58 on the proximal wall 54 does not cant over to grip the needle at two points along the perimeter of the opening to prohibit relative movement between the needle shaft and the tip protector in the protective position.

Applicant further submits that there is no motivation or suggestion to modify the tip protector of FIGs. 1A and 1B when the opening 56 on the arm already provides the needed gripping force in the used position to prevent relative movement between the tip protector and the needle.

Accordingly, because FIGs. 1A and 1B of the '108 reference do not disclose each and every element recited by claims 1, 13, and 27, it cannot anticipate claims 1, 13, and 27 under §102(e).


Because claims 2-12, 14-26, and 28-30 depend on either claim 1, 13, or 27, they too are allowable for at least the same reasons as claim 1, 13, or 27.

Appln No. 10/779,370
Amdt date August 7, 2006
Reply to Office action of June 8, 2006

In view of the remarks set forth above, the application is thought to be in condition for allowance and early notice thereof is respectfully requested.

Should the Examiner finds it necessary to speak with Applicant's attorney, he is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By 
Tom H. Dao
Reg. No. 44,641
626/795-9900

THD/bl
Encls.: Force-diagram
Terminal Disclaimer

BL IRV1098782.1-*08/7/06 2:20 PM